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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,098	06/29/2001	Dwip N. Banerjee	AUS920010560US1	6737
35525	7590	08/12/2005	EXAMINER	
IBM CORP (YA)			JABR, FADEY S	
C/O YEE & ASSOCIATES PC				
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DALLAS, TX 75380			PAPER NUMBER	
			3639	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/895,098	Applicant(s) BANERJEE ET AL.	
	Examiner Fadey S. Jabr	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/19/2001</u> <u>9/11/2001</u> <u>953</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-6, 9, 10, 35, and 37** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V.*

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Diehr, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claim 1 only recites an abstract idea. The recited steps of merely receiving a customized service request, determining if it can be provided based on certain criteria and accepting the request if possible does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to confirm and accept a valid request.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors”

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

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i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754

(Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention determines if the request may be provided (i.e., repeatable) and accepts the service request if possible (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained

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above, claims **1-6, 9, 10, 35, and 37** are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1, 2, 7-12, 17-22, and 27-44** rejected under 35 U.S.C. 102(e) as being anticipated by Domenick et al., Pub. No. US2002/0072937 A1.

As per **Claims 1, 11, 21, 31, and 44**, Domenick discloses a method of accepting reservation requests in a reservation system, comprising:

- receiving a request for a customized service, wherein the request includes customized service parameters that are not predefined by the reservation system (Para. 5, lines 3-4; Para. 12, lines 5-6; Para. 22, lines 9-12; Para. 29 and 35);
- determining if the customized service may be provided based on the customized service parameters (Para. 28, lines 3-6); and
- accepting the request for the customized service if the customized service may be provided (Para. 29, lines 18-23).

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As per **Claims 2, 12, and 22**, Domenick discloses a method wherein determining if the customized service may be provided includes comparing the customized service parameters to a set of rules associated with the reservation system (Para. 37, lines 4-6).

As per **Claims 7, 17, and 27**, Domenick discloses a method further comprising:

- providing a software interface to a client computer, wherein the software interface may be used to submit the request for the customized service (Para. 15).

As per **Claims 8, 18, 28, and 34**, Domenick discloses a method wherein the software interface is one of an applet and a script (Para. 33).

As per **Claims 9, 19, and 29**, Domenick discloses a method further comprising:

- making a reservation based on the request for the customized service; and scheduling the customized service (Para. 38).

As per **Claims 10, 20, and 30**, Domenick discloses a method wherein scheduling the customized service includes scheduling the customized service with one or more service provider reservation systems (Para. 38).

As per **Claim 32**, Domenick discloses a method wherein the at least one client device is coupled to the reservation server via at least one of a data network, a telecommunications network, a cellular network, a satellite communication network, an

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infrared communication network, a Bluetooth network, and a Wireless Application Protocol network (Para. 29, Col. 2, lines 3-9).

As per **Claim 33**, Domenick discloses a method wherein the reservation server transmits a software interface to the at least one client device, and wherein the at least one client device uses the software interface to submit the request (Para. 29).

As per **Claims 35, 38, and 41**, Domenick discloses a method wherein determining if the customized service may be provided based on the customized service parameters includes initiating a communication session between a first party associated with the reservation system and a second party associated with a service provider (Para. 29, Col. 2, lines 18-23).

As per **Claims 36, 39, and 42**, Domenick discloses a method wherein the communication session includes at least one of instant messaging, electronic mail messaging, data network telephony, and conventional telephone communication (Para. 29, lines 3-9).

As per **Claims 37, 40, and 43**, Domenick discloses a method wherein the communication session includes a negotiation between the first party and the second party (Para. 9, lines 5-10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **3-6, 12-16, and 23-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Domenick et al., Pub. No. US2002/0072937 A1 in view of Laval et al., U.S. Patent No. 6,173, 209 B1.

As per **Claims 3, 13, and 23**, Domenick discloses all of the limitations of claims 1, 11, and 21. Domenick fails to disclose a method wherein the rules include rules that are applicable to standard users and rules that define fuzzy areas in which the rules applied to standard users may be relaxed for privileged users. However, Laval et al. discloses a method in which certain customers are entitled to certain routes while the standard customers must wait in line (Col. 3, lines 55-67; Col. 4, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Domenick in order to have less restrictive rules for privileged customers as disclosed by Laval et al. because it would be obvious to want to reward or assist certain customers for their loyalty.

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As per Claims 4, 14, and 24, Domenick further discloses a method wherein if the customized service parameters fall within the rules that are applicable to standard users, the customized service is determined to be able to be provided (Col. 5, Claim 11).

As per Claims 5, 15, and 25, Domenick discloses all of the limitations of claims 1, 11, and 21. Domenick fails to disclose a method wherein determining if the customized service may be provided further includes:

- determining whether a submitter of the request is a privileged user if the customized service parameters fall within the rules that define the fuzzy areas; and
- determining that the customized service is able to be provided if the customized service parameters fall within the rules that define the fuzzy areas and the submitter is a privileged user.

However, Laval et al. discloses a system that determines if a customer is an entitled and whether they made receive the loyalty award for being the entitled customer (Col. 3, lines 55-67; Col. 4, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Domenick in order to determine if the privileged customer is actually entitled to the service as disclosed by Laval et al. because it would be obvious to want only award the customers that are entitled to the service.

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As per **Claims 6, 16, and 26**, Domenick further discloses a method wherein determining if the customized service may be provided further includes:

- requesting the customized service from a service provider;
- receiving a response from the service provider; and
- determining that the customized service may be provided if the response from the service provider indicates that the service provider can provide the customized service (Col. 5, Claim 11).

6. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Domenick et al., Pub. No. US2002/0072937 A1 in view of Kenigsberg et al, Pub. No. US2003/0036928 A1.

As per **Claim 45**, Domenick discloses all of the limitations of claims 44. Domenick fails to disclose a method wherein a fee and arrangements for the customized service are negotiated. However, Kenigsberg et al. discloses a method in which customers can customize their requests for a fee (Col. 8, Claim 11). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Domenick in order to allow a customer to modify their request for a fee as disclosed by Kenigsberg et al. because it would be obvious to want to allow the user a request modification in order to satisfy the customer while at the same time charging them a fee for the modification.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

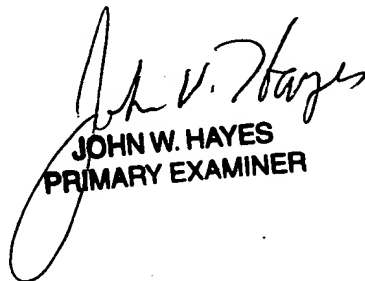
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
Art Unit 3639

fsj


JOHN W. HAYES
PRIMARY EXAMINER